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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/540,993

08/15/2005

Karel Dolezal

J507-005 US

8995

21706 7590 09/07/2007
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EXAMINER

MCINTOSH III, TRAVISS C

ART UNIT

PAPER NUMBER

1623

MAIL DATE

DELIVERY MODE

09/07/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/540,993

Applicant(s)

DOLEZAL ET AL.

Examiner

Traviss C. McIntosh

Art. Unit

1623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 15-21 is/are pending in the application.
- 4a) Of the above claim(s) 18-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 15-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The Amendment filed 6/21/2007 has been received, entered into the record, and carefully considered. The following information provided in the amendment affects the instant application by:

Claims 1-2 have been amended.

Claims 15-21 have been added

Claims 3-14 have been canceled.

Remarks drawn to rejections of Office Action mailed 4/10/2007 include:

101 rejections: which have been overcome by applicant's amendments and have been withdrawn.

Claim objections: which have been overcome by applicant's amendments and have been withdrawn.

112 2nd paragraph rejections: which have been overcome by applicant's amendments and have been withdrawn.

102(b) rejection: which has been maintained for reasons of record.

An action on the merits of claims 1-2 and 15-21 is contained herein below. The text of those sections of Title 35, US Code which are not included in this action can be found in a prior Office action.

Election/Restrictions

Newly submitted claims 18-21 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: these claims are drawn to methods of treatment using the claimed compositions, which are independent or distinct from the compositions themselves. It is noted that no methods of treatment claims were present in the claims originally prosecuted.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 18-21 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Objections

Claim 17 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. It is unclear how the intended use of the composition of claim 17 limits the composition of claim 1 as applicants have not provided any guidance on how the use of the composition will actually limit the composition itself.

Claim Rejections - 35 USC § 102

The rejection of claims 1-2 under 35 U.S.C. 102(b) as being anticipated by Bressi et al. is maintained for reasons of record. newly added claims 15-17 are rejected for the same reasons.

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Bressi et al. discloses compounds meeting the limitations of formula I of claim 1. Moreover, Bressi et al. teach that all compounds they tested were dissolved in DMSO- d_6 . For example, see compounds 27a and 27b in table 1 on page 4138 which are shown to have PGK inhibitory activity (IC_{50} values of 1.0 and 0.6 μ m respectively). Moreover, page 4148, in the right column under "inhibition studies" it is disclosed that "all compounds tested were dissolved in DMSO- d_6 . DMSO is known to be effective in pharmaceutical and cosmetic compositions, as such, the disclosure of at least one species claimed in the instant invention dissolved in a composition which has the capability of use for a pharmaceutical or cosmetic composition is seen to meet the limitations instantly claimed.

It is noted that applicants argued that there was no mention to a composition containing the adenosine derivatives of the instant invention. However, as set forth supra, the examiner believes the Bressi et al. disclosure meets the requirements for 102. Moreover, it is well established that a compound plus a carrier is only allowable if no utility is disclosed for the old compound. See *Ex parte Erdmann*, 194 USPQ 96. In the instant case, Bressi et al. teach their compounds are effective in inhibiting PGK. It is obvious to add a carrier to an obvious compound. See *Ex parte Douros*, 163 USPQ 667 (PTO Bd. App. 1968).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Traviss C. McIntosh whose telephone number is 571-272-0657. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shaojia A. Jiang can be reached on 571-272-0627. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Traviss McIntosh
September 3, 2007

Shaojia A. Jiang
Art Unit 1623
Supervisory Patent Examiner

SAJ 9/4/07